

REMARKS

Claims 44-57, 59-63, 65-84, 86-113 are pending in the Application and all stand rejected in the final Office action mailed December 7, 2010. Claims 44, 50, 51, 53, 57, 59, 60, 63, 67-69, 71, 77, 78, 80, 84, 86, 87, 90, 92, 93, 95, 96, 98, 99, 104, and 109 are amended and dependent claims 114-131 are added by this submission. Claims 44, 63, and 71 are independent claims from which claims 45-62, 90-92, and 114-119, claims 64-70, 93-95, and 120-125, and claims 72-89, 96-98, and 126-131 depend, respectively. Applicants respectfully request reconsideration of pending claims 44-57, 59-63, 65-84, and 86-113, and consideration of new dependent claims 114-131, in light of the remarks set forth below.

As an initial matter, Applicants respectfully note that the Office action includes a rejection of claims 58 and 85 on page 9. Applicants respectfully submit that claims 58 and 85 are not pending in the Application.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Amendments to Claims

Claims 44, 63, and 71 have been amended. Support for these amendments may be found, for example, at FIG. 55a, FIG. 56a and pages 255, 257, 263, and 271-289 of the Specification. Applicants respectfully submit that these amendments do not add new matter.

Claims 50, 51, 77, and 78 have been amended. Support for these amendments may be found, for example, at FIG. 55a and 55b, and pages 258-259 and 264-271 of the Specification. Applicants respectfully submit that these amendments do not add new matter.

Claims 53, 57, 59, 60, 90, and 99 have been amended to make the language consistent with the changes to claim 44. Applicants respectfully submit that these amendments do not add new matter.

Claims 67, 68, 69, 93, and 104 have been amended to make the language consistent with the changes to claim 63. Applicants respectfully submit that these amendments do not add new matter.

Claims 80, 84, 86, 87, 96, and 109 have been amended to make the language consistent with the changes to claim 63. Applicants respectfully submit that these amendments do not add new matter.

Claims 92, 95, and 98 have been amended to clarify aspects of the claimed subject matter. Support for these amendments may be found, for example, at FIG. 56a and pages 283-285 of the Specification. Applicants respectfully submit that these amendments do not add new matter.

Rejections of Claims

Claims 50-52, 77-79, 92, 95 and 98 were rejected under 35 U.S.C. §112, first paragraph. Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, 96, 102-104, 107-109, 112, and 113 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal, *et al.* (US 4,723,238, "Isreal") in view of Suffern, *et al.* (US 5,724,413, "Suffern") and Barberis, *et al.* (US 4,317,195, "Barberis"). Claims 45, 46, 65, 66, 72 and 73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Row, *et al.* (US 5,163,131, "Row"). Claims 62, 70 and 89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Messenger (US 5,046,066). Claims 91, 94 and 97 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Nishimoto (US 4,549,297). Claims 100, 105, and 110 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Melrose (US 5,062,133). Claims 101, 106, and 111 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Hutton (US 6,108,704).

Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow. Nevertheless, Applicants have amended independent claims 44, 63, and 71, and dependent claims 50, 51, 53, 57, 59, 60, 67-69, 77, 78, 80, 84, 86, 87, 90, 92, 93, 95, 96, 98, 99, 104, and 109, as shown and discussed above. Applicants respectfully submit that the amendments to the claims render the rejections of all of pending claims 44-57, 59-63, 65-84, and 86-113 in the instant Office action moot.

I. Claims 50-52, 77-79, 92, 95 And 98 Are Rejected Under 35 U.S.C. §112, 1st¶

Claims 50-52, 77-79, 92, 95 and 98 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection. Applicants have amended claims 50, 51, 77, 78, 92, 95, and 98, and respectfully submit that claims 50-52, 77-79, 92, 95 and 98 are in compliance with 35 U.S.C. §112, first paragraph. Therefore, Applicants

respectfully request that the rejection of claims 50-52, 77-79, 92, 95, and 98 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

II. The Proposed Combination Of Isreal, Suffern And Barberis Does Not Render Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, 96, 102-104, 107-109, 112, And 113 Unpatentable

Claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, 96, 102-104, 107-109, 112, and 113 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal and Suffern, in view of Barberis. Applicants respectfully traverse the rejection.

With regard to independent claim 44, Applicants respectfully submit that claim 44 has been amended so that it now recites “[a] method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks, the method comprising: receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks; providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call; and communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device.” Independent claims 63 and 71 have been amended so that they now recite language similar to claim 44. Applicants respectfully submit that claims 44, 63, and 71 were rejected over the same art using the same rationale. Applicants respectfully submit that the proposed combination of Isreal, Suffern, and Barberis does not teach, suggest, or disclose all aspects of claim 44 and therefore does not render claim 44, or any of the claims that depend from claim 44, unpatentable.

For example, Applicants respectfully submit that claim 44 now recites, in part, “[a] method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks, the method comprising: receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks.” The Office rejects claim 44 over a combination of Isreal, Suffern, and Barberis. In particular, the Office identifies the “network interface controller 14” of Isreal as teaching “method for communicatively coupling a packet network to at least one communication network having an associated information format, the method comprising: receiving, from one of the packet network and the at least one communication network, information requesting setup of a call between the packet network and the at least one communication network.” Neither Suffern nor Barberis are asserted as providing support for the rejection of this aspect of claim 44.

Applicants respectfully submit that Isreal at cited FIG. 1 and col. 3 discloses that “network interface controller (NIC) 14” interfaces a “packet switched system (PSS) 13” to a “circuit switched system (CSS) 12.” Applicants respectfully submit, however, that Isreal does not teach, suggest or disclose “a device for communicatively coupling one of at least two communication networks, each having an associated information format, to either a packet network or another of the at least two communication networks,” and therefore does not teach, suggest, or disclose a method of operating such a device.

In addition, Applicants respectfully submit that Isreal does not teach, suggest, or disclose, at least, “receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks,” as now recited by claim 44. Applicants respectfully submit that Applicants have been unable to discern teachings in either of Suffern and Barberis that remedy the above shortcomings of Isreal. Therefore, Applicants respectfully submit that the proposed combination of references does not teach,

suggest, or disclose at least these aspects of claim 44, does not teach all aspects of claim 44, as required by M.P.E.P. §2142 and §2143.03, and therefore does not render claim 44 unpatentable. Applicants also note that the Office does not assert that either Suffern or Barberis are asserted as providing support in this regard. Applicants believe that claim 44 is allowable over the cited art for at least an additional reason.

Applicants respectfully submit that claim 44 also now recites, in part, “providing, to a host device, at least a portion of the information requesting setup of a call” and “receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call.” The Office asserts that Suffern teaches “providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call. However, Suffern from a similar field of endeavor teaches an interface card that provides received signals to the host device for processing.” (emphasis added) See Office action at page 7.

Applicants respectfully note that the Office again fails to even address, let alone show how and why Suffern teaches “receiving, from the host device, configuration information based upon the at least a portion of the information requesting setup of a call,” admittedly missing from Isreal, further let alone the language of claim 44 that now recites “receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call.” Applicants respectfully note that the cited portions of Suffern at FIG. 1-4, col. 1, line 67 to col. 2, line 2, and col. 2, lines 36-40 fail to provide any teaching of “providing, to a host device, at least a portion of the information requesting setup of a call” **and** “receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call,” as now recited by claim 44. Further, the Office does not assert that Barberis remedies the shortcomings of Isreal and Suffern identified above.

Further, Applicants respectfully note, once again, that the Office fails to provide the “explicit analysis” required by M.P.E.P. §2142. Such analysis is not optional. Instead, the rejection simply repeats a portion of claim 44, and offers only conclusory statements that “Suffern from a similar field of endeavor teaches an interface card that

provides received signals to the host device for processing,” and that “[i]t would have been obvious to modify Isreal incorporate Suffern's teaching in order to reduce the cost of the interface card and to facilitate revision without requiring hardware modification.” Conclusory statements are not sufficient to support a finding of obviousness. See M.P.E.P. §2142. In addition, the Office fails to offer a factual basis that the asserted motivation for making the combination, that is, that “in order to reduce the cost of the interface card and to facilitate revision without requiring hardware modification,” is in fact, would necessarily be realized in making such a combination of Isreal and Suffern.

Applicants respectfully submit that claim 44 also now recites, in part, “communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device.” Applicants respectfully submit that Isreal, Suffern, and Barberis, taken alone or in combination, do not teach, suggest, or disclose at least this aspect of amended claim 44.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the cited art does not teach all aspects of amended claim 44, as required by M.P.E.P. §2142 and §2143.03, that claim 44 is not rendered unpatentable by the cited art, and that claim 44, and any claims that depend therefrom, are allowable over the proposed combination of Isreal, Suffern, and Barberis.

With regard to independent claim 63 and 71, Applicants respectfully submit that claims 63 and 71 recite language similar to that of claim 44, and are rejected over the same art, using the same rationale set forth in rejecting claim 44. Thus, Applicants respectfully submit that claims 63 and 71, and their respective dependent claims, are also allowable over the proposed combination of Isreal, Suffern, and Barberis.

Therefore, for at least the reasons set forth above, Applicants respectfully request that the rejection of claims 44, 47-49, 53-61, 63, 64, 67-69, 71, 74-76, 80-88, 90, 93, 96, 102-104, 107-109, 112, and 113 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combinations Of Isreal, Suffern, And Barberis With Any Of Row, Messenger, Nishimoto, Melrose, And Hutton Do Not Render Claims 45, 46, 62, 65, 66, 70, 72, 73, 89, 91, 94, 97, 100, 101, 105, 106, 110, And 111 Unpatentable

Claims 45, 46, 65, 66, 72 and 73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Row. Claims 62, 70 and 89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Messenger. Claims 91, 94 and 97 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Nishimoto. Claims 100, 105, and 110 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Melrose. Claims 101, 106, and 111 were rejected under 35 U.S.C. §103(a) as being unpatentable over Isreal in view of Suffern, Barberis, and Hutton. Applicants respectfully traverse the rejections.

Applicants respectfully submit that claims 44, 63, and 71, from which claims 45, 46, 62, 65, 66, 70, 72, 73, 89, 91, 94, 97, 100, 101, 105, 106, 110, and 111 depend, are allowable over the cited art, in that Row, Messenger, Nishimoto, Melrose, and Hutton, taken alone or together, do not remedy the shortcomings of Isreal, Suffern, and Barberis, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 45, 46, 62, 65, 66, 70, 72, 73, 89, 91, 94, 97, 100, 101, 105, 106, 110, and 111, that depend from claims 44, 63, and 71 are also allowable, for at least the reasons set forth above. Accordingly, Applicants respectfully request that the rejections of claims 45, 46, 62, 65, 66, 70, 72, 73, 89, 91, 94, 97, 100, 101, 105, 106, 110, and 111 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. Obviousness Guidelines

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not**

optional and must be articulated by the Examiner for the rationale to apply. The seven rationales are listed below.

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

MPEP at § 2141.

If the current rejections are maintained, or any new rejections on grounds of obviousness asserted, the Applicants respectfully request that the Examiner’s Answer:

- 1) **identify the specific Rationale** (i.e., by specifically indicating one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejections so that the Applicants may more clearly address the Examiner’s concerns, and
- 2) **state on the record** the **required** factual findings to support the Rationale that

the Examiner has chosen.¹ Failure to specifically identify the specific rationale and state the required factual findings will seemingly be a tacit admission that the Examiner is unable to satisfy the **required** factual findings.

“It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the necessary factual findings.” See September 1, 2010 Examination Guidelines Update (emphasis added).

Further, it is “Office policy that appropriate factual findings are required in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel must either withdraw the rejection, or repeat the rejection including all the required factual findings.” See *id.* (emphasis added).

Again, it is not enough to simply conclude that a claim is obvious while acknowledging that the cited references fail to disclose particular limitations. See *In re Vaidyanathan*, at pages 18-19. “[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings.**” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

¹ Indeed, the Applicants respectfully request such an explicit analysis and associated factual findings for each and every rejection under 35 U.S.C. §103 of any of the pending claims, as **required** by current PTO practice.

Newly Added Claims

New dependent claims 114-131 have been added. Claims 114-119, 120-125, and 126-131 depend, directly or indirectly, from independent claims 44, 63, and 71, respectively. Applicants respectfully submit that support for claims 114-131 may be found, for example, in FIGs. 55a, 55b, and 56a, and at pages 255, 257-259, 263-270, and 271-289 of the Specification. Applicants respectfully submit that new claims 114-131 do not add new matter, and are allowable for at least the reasons set forth above.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, or the Examiner has any suggestions to move the Application towards allowance, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to arrange an interview.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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